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EXAMINER	
COLLINS, GIOVANNA M	
ART UNIT	**PAPER NUMBER**
3672	

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/616,455	HOFFMAN ET AL
	Examiner	Art Unit
	Giovanna M. Collins	3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *25 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 20050331, 20030924
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-24, drawn to method of treating a well, classified in class 166, subclass 305.1.

II. Claim 25, drawn to apparatus for treating a well, classified in class 166, subclass 191.

III. Claim 26, drawn to method of performing a pressure operation, classified in class 166, subclass 312.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to test the formation fluids.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

806.05(e)). In this case the process does not require an apparatus with a settable seal assembly.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the method of Invention III does not require the formation to be treated.

During a telephone conversation with Bruce Patterson on 3/20/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claim25-26 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claims 5,7,11,13 are objected to because of the following informalities: In claims 5,7,11, and 13, the phrase "the plug portion" should be changed to " the plug assembly". Appropriate correction is required.

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 recites the phrase "equalizing the pressure between the untreated portion of the wellbore and the surface of the well" which is already recited in claim 1, lines 8-9.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,2,4,8-11 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tolman et al. 6,394,184.

Referring to claims 1 and 8, Tolman discloses (fig.4a-4b) a method of treating a well, comprising: positioning a selective treatment assembly with a plug assembly (164) in a wellbore proximate an area of interest, the selective treatment assembly having a

treatment portion (at 114); treating the area of interest (col. 15, line 66-col. 16, line 2); isolating a treated portion of the wellbore from an untreated portion by removing a portion of the selective treatment assembly from the wellbore (col. 19, lines 42-44); equalizing the pressure between the untreated portion of the wellbore and the surface of the well; and completing the well.

Referring to claim 2, Tolman discloses activating a seal (120) to isolate an area of interest (see Fig. 3e).

Referring to claim 3, Tolman discloses deactivating a seal (at 120) and urging the assembly toward the surface of the well (see Fig. 3f).

Referring to claim 4, Tolman discloses pumping fluid through a plurality on injection ports (at 114) on the treatment portion.

Referring to claim 9, Tolman discloses a positioning perforating gun (156) and perforating a string of casing.

Referring to claim 10, Tolman discloses the plug portion (at 162) is secured by a mechanical connection.

Referring to claim 11, Tolman disclose releasing the mechanical connection (Fig. 4b) to separate the plug portion form the assembly.

Referring to claims 15, Tolman discloses the assembly is inserted by coiled tubing (82).

Referring to claim 16, Tolman discloses the assembly is inserted by coiled tubing (82) and a string of jointed pipe (at 110).

Referring to claim 17, Tolman discloses moving the assembly to a second area of interest to isolate and treat the second area of interest (see fig. 4b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 5,7,18-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolman et al. 6,394,184 in view of Baker 4,372,393.

Tolman discloses the method as disclosed in claim 1 but does not disclose sitting the plug portion in a polished bore receptacle disposed in a string of casing. Baker teaches having a polished bore receptacle with sealing elements to have good sealing integrity. As it would be advantageous to have good sealing integrity it would be obvious to one of ordinary skill in the art to modify the method disclosed by Tolman to have a polished bore receptacle as taught by Baker.

Referring to claim 7 and 21, Tolman discloses removing the plug with a retrieval tool (col. 2, lines 13-15).

Referring to claim 18, Tolman discloses (fig.4a-4b) a method of treating a well, comprising: positioning a selective treatment assembly with a plug assembly (164) in a wellbore proximate an area of interest, activated the selective treatment assembly and treating the area of interest (col. 15, line 66-col. 16, line 2); deactivating the assembly (fig 3f) and urging the assembly and plug assembly toward the surface of the well (fig. 4b), seating the plug assembly in the casing and separating a treated portion form an untreated portion; equalizing the pressure between the untreated portion of the wellbore and the surface of the well; removing the plug and producing the well (col. 2, lines 13-15). Tolman does not disclose sitting the plug portion in a polished bore receptacle disposed in a string of casing. Baker teaches having a polished bore receptacle with sealing elements to have good sealing integrity. As it would be advantageous to have good sealing integrity it would be obvious to one of ordinary skill in the art to modify the method disclosed by Tolman to have a polished bore receptacle as taught by Baker.

Referring to claim 19, Tolman discloses a positioning perforating gun (156) and perforating a string of casing.

Referring to claim 22, Tolman discloses the plug portion (at 162) is secured by a mechanical connection.

Referring to claims 23, Tolman discloses the assembly is inserted by coiled tubing (82).

Referring to claim 24, Tolman discloses the assembly is inserted by coiled tubing (82) and a string of jointed pipe (at 110).

3. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolman et al. 6,394,184 in view of Baker 4,372,393 as applied to claims 5 and 18 and further in view of Simpson.

Referring to claims 6 and 29, Tolman, as modified, does not disclose attaching a string of production tubing to or above a polished receptacle. Simpson teaches it is known in the art to attach a production tubing to existing casing (see col. 1 ,lines 11-20). As it would be advantageous to have attach production tubing it the casing becomes damaged, it would be obvious to one of ordinary skill in the art to modify the method disclosed by Tolman to attach production tubing above or to a polished receptacle (via the casing string) as taught by Simpson.

4. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tolman et al. 6,394,184.

Tolman discloses the method of claim 11 but does not disclose a mechanical connection is a shear pin. Tolman does discloses a shear pin is a type of releasable mechanical connection (col. 13, lines 55-57). As it would be advantageous to have a shear pin that connects the plug to the assembly and is easily released with ready to set the plug, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Tolman to have a shear pin.

5. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tolman et al. 6,394,184 in view of Rosenthal 3,642,064.

Referring to claims 13-14Tolman discloses the method of claim 1 but does not disclose a x lock profile. connection is a shear pin. Rosenthal teaches a plug with an x-lock profile seated in a profile to helps to ensure a plug will stay in place. As it would be advantageous to have connection to ensure the plug will stay in place when fluid exerts a pressure beneath it, , it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Tolman to have a x-lock profile.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gmc

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